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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,602	01/31/2002	Cristian Libanati	W9490-02	3426

7590

06/16/2004

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EXAMINER
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KRASS, FREDERICK F

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/062,602	<b>Applicant(s)</b> LIBANATI ET AL.	
	<b>Examiner</b> Frederick F. Krass	<b>Art Unit</b> 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) 13-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Restriction Requirement**

1) Insofar as the previous restriction/election of species requirement(s) can be understood, it appears that claims 13-17 are drawn to non-elected claims, and that an issue of potential rejoinder under In re Ochai/Brouwer may exist.

2) The previous examiner should have provided the following information to Applicant:

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the

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requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

3) Insofar as the current examiner can determine, there is no reason claims 1-9, 11 and 12 should not have been included with the examined subject matter.

Accordingly, they are included in the rejection which follows hereinunder.

4) Claims 13-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### **Anticipation Rejection**

Claims 1-9, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Durga et al (USP 6,290,933).

Applicant has amended claims 1 and 6 to recite that the "particulate comprises a mixture of a first silica gel washed at a first temperature and a second silica gel washed at a second temperature different from said first temperature", and argues that the prior art does not fairly suggest, teach or disclose using two different gels.

Where the newly added claim limitation is interpreted as broadly as is reasonable, however, it appears that the claims are not in fact drawn exclusively to final products comprising two different silica particulates.

Applicant's specification teaches that "the temperature of the wash solution affects the properties of the hydrous silica gel product" (paragraph [0020]). The conditions used, however, are specific: for the first particulate, 80 to 130 degrees for 6 to 15 hours (pagragraph [0021]), and for the second particulate, 110-200 degrees for 12-20 hours. The instant claims, by contrast, are inclusive of any times and temperatures. Where the differences in wash temperature were minor, and/or washing was conducted at lower temperatures and/or for shorter times, one would not expect a material difference in properties - once mixed following washing, only one particulate would be present. Accordingly, the instant product-by-process limitation is not seen to distinguish over the particulates of the prior art.

Applicant also argues that the present invention provides unexpected results with

regard to cleaning performance. Specifically, dentrifice "B" on page 11 of the instant specification is cited to demonstrate unexpectedly improved PCR, RDA, and Einlehner abrasion properties as compared to commercially available silica gel and precipitated silica abrasives, including combinations of the two (as used in composition "C"). This argument is not pertinent to the instant rejection, since anticipation cannot be overcome by showings of unexpected results. Furthermore, it would not be persuasive even if the claims were obvious since these results were not obtained in a direct side-by-side comparison to the applied prior art. Indeed, the PCR, RDA and Einlehner properties disclosed by Durga et al appear to be comparable to those observed by Applicant, such that were a direct comparison made one would not expect to see unexpected results. (See the working examples of Durga et al, where those values are specifically measured).

**Action is Final**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick F. Krass whose telephone number is 571-272-0580. The examiner's schedule is as follows:

Monday: 6:30-3:00PM;  
Tuesday: 10-6:30PM;  
Wednesday: off;  
Thursday: 10-6:30PM; and  
Friday: 10-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seidel Marianne, can be reached on 571-272-0584. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Frederick Krass  
Primary Examiner  
Art Unit 1614

A handwritten signature in black ink, appearing to read "Frederick Krass", written over the printed name.